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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/15/2001

Michael Taylor

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10/11/2006

SCHIFF HARDIN, LLP
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EXAMINER

ADE, OGER GARCIA

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,663

Applicant(s)

TAYLOR ET AL.

Examiner

Garcia Ade

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed on August 8th, 2006 under 37 CFR 1.131 has been considered. Applicants amended claims 1 and 17.
2. The Examiner withdraws the 112, second rejection of claim 17, but maintains the 112, second rejection of claim 7.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Double Patenting

5. Claims 1 - 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 24 of copending Application No. US 09/979,911. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 – 23 are rejected under 35 U.S.C. 102(b) as being anticipated by "Single Source Maintenance" by Paul Bird.

Regarding claim 1, Bird teaches providing motor maintenance services on a pro-active basis [see "Whole service Portfolio", lines 16 - 17]; and providing modules of said motor maintenance services wherein said modules are standardized and freely combinable with one another [see "Whole service Portfolio", lines 14 - 19]; agreeing to perform the related services of the modules, said agreeing being prior to identification of a failure or predicted failure [see for example "Whole Service Portfolio", lines 16-17]. Examiner notes that a contract for a straight fix a problem as it arises approach meets the requirements of this limitation.

Regarding claim 2, Bird teaches providing a menu of motor services offered to the customer, said motor services being modular [see "Whole Service Portfolio", lines 1-2 and lines 7-9]. Examiner notes that a "range of offerings" (see line 7) represents a menu or "a comparable list of assortment of offerings" [Webster's Ninth New Collegiate Dictionary]; performing ones of said modular motor services which are selected by the customer as outsourced services, said services being customized according to the customer's need.

Regarding claim 3, Bird teaches performing an evaluation of a customer's technical practices and facilities regarding the motor management [see "Whole Service Portfolio", lines 35 – 38]; providing a menu of motor services offered to the customer, said menu including modular motor services available on an outsourced

basis [see "Whole Service Portfolio", lines 1-2 and lines 7-9]; making recommendations to the customer of selected ones of said modular motor services based on results of said evaluation [see "Whole Service Portfolio", lines 35 - 38]; and providing on an outsourced basis ones of said modular services selected by the customer [see "Whole service Portfolio", lines 14 - 19].

Regarding claims 4 - 6, Bird teaches the steps of changing (valuing) compensation of said outsourced modular services depending on performance indicators; and providing said technical and maintenance services in two performance levels [see all of "Whole Service Portfolio", lines 1 and 2]. The Examiner notes that the article is written to encompass a "one-stop" outsourcing plan, therefore these three levels of services are clearly included in this strategy.

Regarding claim 7, Bird teaches the step of universally performing the motor maintenance services from managing, planning and coordinating the services down to operational activities with the processes implemented across all functions [see for example performance levels, lines 5 - 8]. The Examiner notes that the outsourcing of an entire department represents the suppliers providing managing, planning and coordinating services down to operational activities across all functions.

Regarding claim 8, Bird teaches the step of providing condition monitoring derived from a business based maintenance analysis [see "Whole Service Portfolio", lines 20 and 21].

Regarding claim 11, Bird teaches services are aimed to maintain motors manufactured by the service provider as well as OEM motors [see abstract]. The

Examiner notes that the article states that it is not uncommon to find 20 different suppliers involved in maintenance of information and technology environments. This is because suppliers maintain their own equipment. Bird teaches this as the normal practice at the time of the article.

Regarding claim 12, Bird teaches services include a motor upgrade [see for example "Whole Service Portfolio", lines 1 - 2].

Regarding claim 13, Bird teaches services include evaluating motors for upgrade possibilities in order to improve their functionality [see for example "Whole Service Portfolio", lines 1 - 2].

Regarding claim 14, Bird teaches services include verifying the motor reliability [see for example "Whole Service Portfolio", lines 20 - 22].

Regarding claim 15, Bird teaches services include providing maintenance services aligned to the customer's changing business objectives [see for example "Whole Service Portfolio", lines 30 - 38].

Regarding claims 16 - 19, Bird teaches performing a motor management review [see "Whole Service Portfolio", lines 35 - 38].

Regarding claim 20, Bird teaches each motor category is weighted according to its criticality, the weighted-score can be summarized to provide an overall motor condition evaluation, which can be compared to other points in time [see for example "Whole Service Portfolio", lines 20 - 22 and 30 - 31].

Regarding claim 21, Bird teaches providing services on performance-oriented contract basis [see "Whole Service Portfolio", lines 18 - 22].

Regarding claim 22, Bird teaches the steps are implemented according to the prescriptions of a service manual [see "Choosing the Supplier", lines 1 – 13].

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bird, and further in view of Miller [US 5,202,825].

Regarding claims 9 and 10, Bird discloses all elements per claimed invention as explained above. Bird does not explicitly disclose providing an inventory optimization and reduction with a goal of reducing spare motors warehousing; and providing a shared inventory with a goal of reducing motor inventory investment and carrying cost as well as storage, maintenance, and occupancy. However, Miller discloses that it is old and well known in the art to control inventories [see figure 1 (e.g. system 21 for inventory control functions)].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bird with the inventory control system noted by Miller, because inventory management reduces inventory costs.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bird, and further in view of Discenzo [US 6,434,512].

Regarding claim 23, Bird does not explicitly disclose the industrial system is one of a airport, steel mill, hospital, mines, ship yard, large building, hotel, chemical plant, cement plant, subway system, railway system, container terminal, oil drilling rig or platform, paper mill, oil or natural gas pipeline system, lime plant, water treatment plant including desalination, fresh water pipelining and waste water treatment, and food service facilities.

However, Discenzo disclose the industrial system is one of a airport, steel mill, hospital, mines, ship yard, large building, hotel, chemical plant, cement plant, subway system, railway system, container terminal, oil drilling rig or platform, paper mill, oil or natural gas pipeline system, lime plant, water treatment plant including desalination, fresh water pipelining and waste water treatment, and food service facilities [see column 25, lines 29 – 33].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bird with the Discenzo industrial system. The motivation to combine will provide a method for collecting and processing data relating to a plurality of subsystems of a dynamic system includes a plurality systems [see abstract].

Response to Arguments

11. Applicants' arguments with respect to claims 1 - 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571.272.6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Garcia Ade
Examiner
Art Unit 3627

ga


Primary Examiner, AU 3627